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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/601,702

06/24/2003

Roland Hahn

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02/20/2009

ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.

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EXAMINER

DESAI, ANISH P

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

02/20/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/601,702	<b>Applicant(s)</b> HAHN, ROLAND	
	<b>Examiner</b> ANISH DESAI	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7-11,15,17 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 and 19-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,15 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's arguments in response to the Office action dated 11/01/07 and 10/20/08 have been fully considered.
2. The 35 USC Section 112-second paragraph rejections made by the previous Examiner are withdrawn.
3. All of the previously made art rejections by the previous examiner are withdrawn in view of Applicant's arguments and reviewing the prior art as a whole.
4. The obviousness type double patenting rejection made by the previous examiner is withdrawn.
5. A new 35 USC Section 112-second paragraph rejection is made.
6. A new 35 USC Section 103(a) rejection based on Hauptman (US 4,356,676) in view of Inouye et al. (US 5,112,682) is made.

### ***Election/Restrictions***

7. Applicant's election of claims 1, 3, 4, 7, 15, and 17 in the reply filed on 11/18/08 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Accordingly, claims 8-11 and 19-26 are withdrawn.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3, 15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. Regarding claim 3, it is not clear as to whether Applicant intends to claim that there are some areas on the first surface that are coated with a cement other than a silicone cement or that the silicone cement contains (e.g. mixed with) other type of cement. For the purpose of the examination, if a prior art discloses a first surface that is coated with a mixture of silicone cement with other adhesive material, then it will meet the requirements of claim 3.
10. Claim 15 recites that the carrier element is a "flexible tape". It is unclear as to what structure/composition is imparted by recitation "flexible tape".
11. Claim 17 recites "sealing body". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 7, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauptman (US 4,356,676) in view of Inouye et al. (US 5,112,682).
13. Regarding claim recitation “for attachment of a sealing element made...to an application site” is interpreted as an intended use of the adhesive tape.
14. Hauptman discloses a sealant strip (equated to adhesive tape) having a foamed resin core (equated to carrier element) comprising a **cured** silicone rubber sealing layers on two surface of the core (abstract and column 2 lines 55-60) (equated to a first and second self-sticking adhesive surfaces, one on each side of the carrier element and cross-linked silicone cement). It is further submitted that Applicant has not cited any particular composition related to the silicone cement other than reciting “silicone cement”. Therefore, the cured silicone rubber sealing layer of Hauptman is equated to read on the silicone cement as claimed.
15. The difference between the claimed invention and the prior art of Hauptman is that Hauptman is silent as to teaching “an intermediate adhesion layer between the first self-sticking adhesive surface and the carrier element”.

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16. However, Inouye discloses a primer composition (equated to an intermediate adhesion layer that is formed by a film) that is capable of imparting good adhesion to even hardly adherable plastics such as polyolefins (abstract and column 1 lines 1-10).

17. Additionally at column 8 lines 5-28, Inouye discloses following:

**The primer of this invention, when coated on the surfaces of various materials, can impart adhesion on the surfaces. In particular, it is effective in instances in which so-called hardly adherable plastics such as polyethylene, polypropylene, Teflon, polyphenylene sulfide, polyethylene terephthalate, modified polyphenylene ether, polybutylene terephthalate, polyacetal, polycarbonate and nylon are adhered to the like materials or other materials with use of a silicone adhesive, polyurethane adhesive, polysulfide adhesive, modified silicone adhesive or epoxy adhesive, or in instances in which a silicone sealant, coating medium, potting medium or the like is adhered to the surfaces of the above slightly adherent materials. Among these, it is particularly effective when the silicone adhesive, sealant, coating medium or potting medium is used.**

**The above silicone adhesive, sealant, coating medium or potting medium may include, for example, room temperature curing silicones and heat curing silicones. They are exemplified by KE45, Sealant 72, Sealant 90, Sealant 70, Sealant 80, KE3497 and KE3498, which are commercially available products of Shin-Etsu Chemical Co., Ltd.**

18. It is noted that the primary reference of Hauptman applies a cured silicone sealing layer to a core (abstract) that is formed of plastic materials. Secondary reference of Inouye discloses a primer layer that can be used to bond plastic material to adhesive/sealants that are based on silicone. Further, it is noted that the

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19. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the primer layer of Inouye in the invention of Hauptman, motivated by the desire to provide suitable adhesion between the core of Hauptman and the sealing layer.

20. Regarding claims 15, since Applicant has not defined what is meant by the "flexible tape", the foam core of Hauptman is equated to meet said claim.

21. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hauptman (US 4,356,676) in view of Inouye et al. (US 5,112,682) as applied to claim 1 above, and further in view of Mazurek et al. (US 5,264,278).

22. Hauptman is silent as to teaching claim 3.

23. However, Mazurek discloses radiation curable acrylate/silicone PSA coated tapes (abstract and title). Further, at column 1 lines 50-55 Mazurek discloses a hybrid adhesive system containing acrylate and silicone. Additionally, at column 1 lines 15-25, Mazurek discloses that adhesive tapes are finding use in applications such as body sealing weatherstripping.

24. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the first self-sticking surface as that of claimed by the presently claimed invention, because selection of a known material based on its suitability for its intended use establishes a *prima facie* case of obviousness.

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25. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hauptman (US 4,356,676) in view of Inouye et al. (US 5,112,682) as applied to claim 1 above, and further in view of Johnston et al. (WO 99/16618), where US 6,284,360B1 to Johnson et al. is relied upon as an equivalent document for convenience.

26. Regarding claim 4. Johnson discloses a multilayer tape having a core and a layer of sealant applied to the core layer (abstract and title). As the core layer, Johnson discloses various foam layers that can be used including acrylic foam (abstract, column 3 lines 40-50, and column 9 lines 6-65).

27. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the acrylate foam, because selection of a known material based on its suitability for its intended use establishes a *prima facie* case of obviousness.

### ***Response to Arguments***

28. Applicant's arguments filed on 11/01/07 have been fully considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.



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30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./  
Examiner, Art Unit 1794

/Hai Vo/

Primary Examiner, Art Unit 1794